

REMARKS

I. Status of the Claims

Claims 22-58 are pending in this application. Applicants acknowledge and appreciate the withdrawal of the double patenting rejection. Applicants respectfully request reconsideration and withdrawal of the one remaining rejection, and timely allowance of the pending claims.

II. Rejection Under 35 U.S.C. § 103

Aaslyng in view of Audousset

The Office maintains its rejection of claims 22-58 under 35 U.S.C. § 103(a) as obvious over *Aaslyng et al.*, WO 97/19999 ("Aaslyng '999") in view of *Audosset et al.*, U.S. Patent No. 5,769,903 ("Audosset") for the reasons of record, and as supplemented at pages 2-3 of the final Office Action dated October 8, 2002. Applicants respectfully traverse this rejection for the reasons of record and supplemented as follows.

In response to Applicants previous arguments, the Office alleges that "the primary reference suggests the genus of the para-aminophenol as an oxidation base in the dying composition while the secondary reference teaches the species of 4-amino-3-methylphenol...Therefore, the combination is proper and the *prima facie* case of obviousness has been established." (final Office Action, page 3.) Applicants traverse this rejection, at least because the Office has failed to provide any motivation for the

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Aaslyng '999/Audosset combination, as is required to establish a *prima facie* case of obviousness.

The Federal Circuit requires evidence of a suggestion or motivation to modify the teachings of prior art references. See, e.g., *In re Dembicza*k, 50 USPQ.2d 1614 (Fed. Cir. 1999). Modifying prior art references without evidence of such a suggestion or motivation simply takes the inventor's specification as a blueprint for piecing together the prior art to defeat patentability, *i.e.*, the essence of hindsight. *Id.* at 1617. This is why the Federal Circuit placed the burden on the Office to present "clear and **particular**" **evidence** showing motivation to combine or modify. *Id.*, emphasis added. More recently, the Federal Circuit has also held that:

This factual question of motivation is material to patentability, and could not be resolved on **subjective belief and unknown authority**. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to '[use] that which the inventor taught against its teacher.' ... Thus the [Office] must not only assure that the requisite findings are made, based on evidence of record, but must also **explain the reasoning** by which the findings are deemed to support the agency's conclusion.

In re Lee, 277 F.3d 1338, 1433, citations omitted, emphasis added (Fed. Cir. 2002).

Applicants point out that the Office has again mischaracterized the teachings of Aaslyng'999. Specifically, the Office alleges that Aaslyng'999 teaches "the genus of the para-aminophenol as an oxidation base." See Office Action, page 3. Applicants disagree, and submit that Aaslyng'999 discloses the singular para-aminophenol as a species of oxidation base, rather than the plural genus of para-aminophenols as alleged by the Office. For example, Aaslyng'999 at page 9, line 23, to page 10, line 19,

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discloses a large number of dye precursor species (such as p-aminophenol and o-aminophenol) and several genera of dye precursors (such as phenazines, p-amino-benzoic acids) with examples of species within each of the genera. In each instance, one of ordinary skill would understand which is a species and which is a genus. In particular, p-aminophenol is clearly identified as a single species and all genera are clearly recognizable as genera because of the use of the plural and the disclosure of species within the genus. For this reason, Applicants submit that Aaslyng'999 fails to encompass or disclose the genus of para-aminophenol as asserted by the Office.

Furthermore, since Aaslyng'999 merely teaches the singular species para-aminophenol and Audousset discloses 4-amino-3-methylphenol, Applicants submit that the Office has failed to provide any motivation for the combination because merely selecting certain possible components from each reference to devise the composition of the claimed invention, without further motivation in the art, is an insufficient basis for maintaining a *prima facie* case of obviousness. Indeed, the Office has not provided any substantial evidence for substituting Aaslyng'999's para-aminophenol species with Audousset's 4-amino-3-methylphenol species.

In addition, the Office has still failed to provide adequate motivation for the combination because Audousset merely teaches compositions comprising at least one oxidation base, at least one coupler selected from indole couplers, and at least one additional heterocyclic coupler. See Audousset, column 2, line 10 to column 3, line 58. The composition of Audousset is substantially dissimilar to the composition of Aaslyng

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'999, which comprises a laccase enzyme and at least one dye prescuror. See Aaslyng '999 abstract. Applicants respectfully submit that the Office has not properly pointed to anything in the references that would have led to the addition of Audousset's 3-methyl-4-aminophenol oxidation base to the composition of Aaslyng'999. The Office has therefore failed to provide substantial evidence of why one of ordinary skill in the art would have been motivated to combine these two references to devise a particular composition comprising an oxidation base chosen from 3-methyl-4-aminophenol and the addition salts thereof, and at least one laccase enzyme.

Accordingly, Applicants respectfully request reconsideration and withdrawal of the rejection.

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CONCLUSION

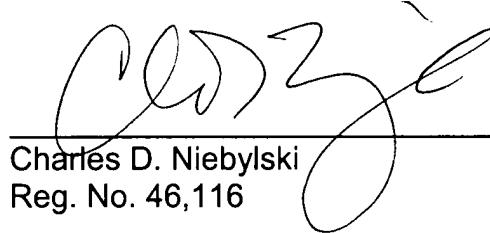
In view of the foregoing remarks, Applicants respectfully request reconsideration and withdrawal of the rejections and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this Amendment and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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